

REMARKS/ARGUMENTS

35 USC § 102(b)

Claim 1-8 were rejected under 35 USC § 102 (b) as being anticipated by Ming. The applicant disagrees, especially in view of the amendments made herein.

As amended, claims 1-8 expressly require that the "...tail comprises a *material having sufficient resiliency to maintain* a spiral shape of the tail during flight when the toy is thrown into the air by a user..." and that the "...the *material further has sufficient resiliency to maintain* the shape of the spiral-shaped tail substantially the same when the head portion is moved along a resting horizontal a surface as compared to the shape of the tail when the toy is not in motion..." *This is in contrast to Ming's teaching in column 2, lines 39 et seq., in which the coils requires substantial deformation to function in its intended purpose.*

It should be noted that such limitation is clearly structural and not based on an intended use. Use of functional terms in the description of a structural element is well recognized by the Office as can be taken from MPEP 2173.05(g). Such language was also clearly accepted in the case law dealing with such issues (see e.g., *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971), *In Innova/Pure Water Inc. v. Sufuri Water Filtration Sys. Inc.*, 381 F.3d 1111, 1117-20, 72 USPQ2d 1001, 1006-08 (Fed. Cir. 2004), *In re Barr*, 444 F.2d 588, 170 USPQ 33 (CCPA 1971), or *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976)).

The office further stated that the weight ratio of the head to tail in the Ming patent would be between 1:1 and 20:1. The applicant disagrees for at least the following reason: If the head portion is significantly heavier than the tail (i.e., the spiral and opposing head), Ming's toy would simply fall off the wall drawn by the falling head portion. While the applicant agrees to some degree that the head to tail weight ratio may be around 1:1, the applicant certainly disagrees that Ming's weight ratio will be greater than 3:1 or greater than 5:1 (based on the function and Ming's general description). Therefore, the *applicant further amended claim 1 to expressly require a weight ratio of between 10:1 and 20:1.* it should be noted that the wiggling motion in flight is not produced by any head to tail ratio, and that a head to tail ratio of between about 10:1 and 20:1 is critical for the desired wiggling flight pattern.

Claim 1, and 3-8 were rejected under 35 USC § 102 (b) as being anticipated by Pacza. Again, the applicant respectfully disagrees, especially in view of the amendments made herein and points to the arguments and amendments provided above.

It should be noted that the toy according to Pacza has a substantially soft spring, which is inconsistent with the presently claimed subject matter. Such soft spring is clearly seen in Figures 4-6, and description (see e.g., column 2, lines 13-14: "Spring coil is made from metal or plastic with superb extendibility"). With respect to the office's argument that the head to tail ratio would be between 20:1 and 1:1, the applicant disagrees. At best, and considering the material description by Pacza's, the weight ratio may be between 3:1 and 1:1, but certainly not between 10:1 and 20:1. Among other things, if the head would be disproportionally heavier than the tail (e.g., 5:1 to 7:1), Pacza's toy would not exhibit the springing motion as described (e.g., in paragraph spanning column 2 and 3).

35 USC § 103

Claim 9-16 were rejected under 35 USC § 103 as being obvious over Ming, and **claims 9 and 11-16** were rejected under 35 USC § 103 as being obvious over Pacza. The applicant again respectfully disagrees.


As already provided above, neither Ming nor Pacza teach each and every element present in the amended claims. Moreover, amended claim 9 also requires that "...the head portion and the tail are coupled to each other such that a wiggling motion of the toy is enabled in which the tail rotates about the longitudinal axis..." Such limitation is again a structural limitation that can be easily ascertained by a person of ordinary skill in the art.

All Ming teaches is a pendulum-like motion of the toy when the toy is falling down a wall. Such motion is inconsistent, if not even contrary to the presently claimed subject matter. Similarly, Pacza fails to make any reference of motion other than that the spring expands or bends along its longitudinal axis. Again, such motion is inconsistent, if not even contrary to the presently claimed subject matter.

In view of the present amendments and arguments, the applicant believes that all claims are now in condition for allowance. Therefore, the applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

RUTAN & TUCKER



Martin Fessenmaier, Ph.D.
Reg. No. 46,697
611 Anton Blvd., 14th Floor
Costa Mesa, CA 92626
Tel.: (714) 641-5100